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10/577,594	04/26/2006	Roxanne Costello	18278US01	6659
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EXAMINER DEODHAR, OMKAR A				
ART UNIT 3714		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mhmpto@mcandrews-ip.com

Office Action Summary**Application No.**

10/577,594

Applicant(s)

COSTELLO ET AL.

Examiner

OMKAR DEODHAR

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This responds to Applicant's amendment and arguments submitted 5/9/2011.
2. Claims 1-30 are pending.

Response to Arguments & Amendment

3. Applicant's arguments, drawn towards the presently amended claims, have been considered but are unpersuasive. The claim amendments are addressed in the discussion below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amendment to claims 15 and 28 recites, inter alia, "only if special feature indicium is revealed..." This is grammatically incorrect and should recite either (1) "only if a special feature indicium is revealed..." or (2) "only if special feature indicia are revealed."

Applicant's attention is requested.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5, 9-11 & 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055).

Regarding Claims 1, 4, 5, 11, 18, 24: Walker discloses an instant lottery game system and device, (Abstract, tickets for a lottery game system) which includes: a game play defining element, (Fig. 2, ticket 100 defines the game); a symbol display zone carried on the game play defining element, (Fig. 2, zone 130 contains outcomes comprising symbols), the symbol display zone containing a plurality of symbols providing a reel game outcome; (Fig. 2, zone 130 contains video poker outcomes. Since video poker is a reel game, the video poker outcome is a reel game outcome); a symbol interpretation zone carried on the game play defining element, (Fig. 2, zone

140. Zone 140 explains the payout provided for each outcome. For example, zone 140E explains an outcome from zone 130E as a "straight." Thus, since zone 140E is used to interpret the outcome from zone 130E, it is a symbol interpretation zone.);

a masking medium covering the symbols of the symbol display zone and the symbol interpretation zone prior to game play; (Col. 8. Lines 35-45, scratch off latex coating covers zones 130 and 140 on the game play defining element 100); and wherein the symbol interpretation zone is carried on the game play defining element, (Zone 140 is carried on game play defining element 100), the symbol interpretation zone carrying a plurality of indicia used in interpreting said symbols of said reel game outcome revealed in the symbol display zone after removal of the masking medium to determine a prize for said outcome, (symbol interpretation zone 140 carries indicia used in interpreting the reel game outcomes revealed in symbol display zone 130 after the scratch off coating is removed, to determine a prize for the outcome. For example, symbol interpretation zone 140E carries a plurality of indicia comprising the text, "Straight You Win!" corresponding to the reel game outcome in zone 130E, "A-K-Q-J-10." It also carries indicia reflecting the payout amount "\$4.")

Walker discloses the invention substantially as claimed but since Walker's game is an implementation of a video poker reel game, Walker's symbol display zone 130 contains symbols representing cards used in poker and thus, Walker's symbol display zone 130 does not contain a plurality of symbols representative of a *spinning* reel game outcome, (Emphasis Added.) Moreover, since Walker's symbol interpretation zone 140 carries indicia used in interpreting symbols of a video poker reel game outcome, Walker does not teach that symbol interpretation zone 140 is used in interpreting symbols of a *spinning* reel game outcome. (Emphasis Added.)

However, Walker teaches that applying a slot machine theme (a spinning reel game) to an instant lottery ticket game is known in the art. (Walker, Col. 1. Lines 45-50) Walker teaches that when a slot machine theme is applied to an instant lottery ticket, printed indicia would include symbols customarily used by slot machines and would also include a picture or symbol of a slot machine. (Walker, Col. 1. Lines 45-50.).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Walker's poker theme on the game ticket 100 with a slots or spinning reel game, representing a spinning reel game outcome instead of a video poker reel game outcome, as taught by Walker to be known in the art, for the purpose of tailoring a ticket game to a particular theme. (Walker, Col. 1. Lines 45-50.). Persons of ordinary skill in the art would realize that when the theme is video poker, game symbols would be playing cards traditionally used in playing poker. Likewise, persons of ordinary skill in the art would realize that when the theme is slots, game symbols would be representative of a slots game. For example, when implementing a slots theme, as proposed above, Walker's symbol display zone 130 would show slot symbols including cherries, lemons, oranges and bars. (Walker Col. 1. Lines 45-50.) Likewise, when implementing a slots theme, as proposed above, Walker's symbol interpretation zone 140 would explain combination of cherries, lemons, etc., if any, that correspond to the slots outcome in zone 130. This would work just as one would expect it to because it merely requires replacing a video poker theme with a slots or spinning reels game, theme.

Regarding Claims 2, 3, 19, 20: Walker as modified above teaches a prize indicating zone being carried on the game play defining element and that the zone includes a payable and a

range of prizes which a player can win by playing a game on the game defining element. (Fig. 2, payout zone 140 is a prize indicating zone because it indicates prizes. Payout zone 140 indicates a range of prizes {from \$0 to \$4} that a player can possibly win as a result of game play. It is printed on ticket 100, which is a game play defining element.)

Regarding Claims 9, 22: Walker as modified above teaches that recourse to the symbol interpretation zone is required to determine what prize, if any, has been won and revealing of the symbols on their own does not indicate to the player what prize, if any, has been won. (Fig. 2. Recourse to symbol interpretation zone 140 is required to determine what prize, if any, has been won and revealing symbols in zone 130 does not on its own indicate a prize amount. {Revealing symbols in zone 130 merely reveals a combination of symbols that is by itself insufficient to determine a prize award quantity.})

Regarding Claims 10, 23: Walker as modified above teaches that the masking medium comprises first and second masks, and wherein the first mask covering the symbol display zone, and wherein the second mask covering the symbol interpretation zone. (Walker Fig. 2, the symbol display zone is zone 130 and the symbol interpretation zone is zone 140. Note the instructions in area 150. See Col. 8. Lines 35-45. Different regions on the ticket 100 are covered with different masks. This interpretation is bolstered by at least two factors: First, the instructions in area 150 of ticket 100 require separate steps of scratching of areas on the ticket, suggesting separate and multiple masked regions. Second, the ticket 100 includes printed text {e.g. "Strategy", "Outcome", "Payout", etc.} above each region which is configured to be scratched off, suggesting separate and multiple masked regions disposed so as to not overlap the printed text.)

Regarding Claim 21: Walker as modified above teaches that the ticket 100 of Figure 2, which is a game defining element, is a carrier on which the symbol display zone, interpretation zone and prize indicating zone are carried because the ticket has these zones printed on it.

9. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Kamille (US 6,237,913.)

Claims 6-8: Walker as modified above teaches the invention substantially as claimed but does not teach implementing the system in an electronic format to be played on an electronic device, such that the game play defining element is a representation of a card displayed on a screen of the electronic device and, in which the masking medium is a virtual covering layer that is “removed” by a player operating predetermined controls of the electronic device.

However, in a related invention, Kamille teaches scratch off ticket games that may be implemented in an electronic format on a electronic game device. (Kamille, Col. 5. Lines 25-42.) When Kamille's scratch off game is implemented electronically, the game ticket would be virtually displayed on a screen; thus represented as a card on a display screen. (Kamille, Col. 5. Lines 25-42.) Further, Kamille teaches that the user makes a selection thereby operating predetermined controls to virtually uncover otherwise masked elements. (Kamille, Col. 5. Lines 25-42.)

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to implement the scratch off ticket game taught by Walker in view of “Background of the Invention” as an electronic game on an electronic game device, as taught by Kamille, for the purpose of providing an alternate game format. Persons of ordinary skill in the

art would appreciate that physical games can be played electronically and that some people may prefer to play electronically versus on an actual, physical card.

10. Claims 12, 13, 17, 25, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Dietz (US 5,949,042).

Regarding Claims 12, 13, 25, 26: Walker as modified above teaches the invention substantially as claimed but does not teach that the indicia of the symbol interpretation zone include operators related to spinning reel-type game operations, nor, does Walker in view of "Background of the Invention" teach that the operators vary the prizes or prizes awarded to a player so that, until the symbol interpretation zone has been referenced by the player, the player will not know what prize or prizes, if any, the player will receive.

However, in a related invention, Dietz teaches providing a symbol interpretation zone 13 on a printed lottery ticket 10. (Dietz, Fig. 1A.) Dietz's symbol interpretation zone provides a correlation between slot game outcomes and prize amount. Further, Dietz's symbol interpretation zone include certain "bonus pays" for unique combinations. Dietz's "bonus pays" are interpreted as teaching the claimed "operators" because they operate to enhance awards for unique combinations. Also, until a player references Dietz's symbol interpretation zone 13, the player will not know what prize(s), if any, the player will receive.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to replace the symbol interpretation zone taught by Walker (that is, the zone defined by area 140 on ticket 100) with Dietz's symbol interpretation zone that includes bonus operators related to slot game outcomes, for the purpose of tailoring the game towards slot-reel type gaming. As pointed out above, Walker teaches that it is known in the art to tailor

game tickets for gaming themes and Walker specifically discloses tailoring a game ticket to slots play. As such, if a game ticket is poised towards slot play, a person of ordinary skill in the art would appreciate that a symbol interpretation zone would likewise be tailored towards slot play.

Regarding Claims 17, 30: Walker in view of Dietz teaches that the indicia of the symbol interpretation zone are directly related to the prizes awarded rather than the symbols of the symbol display zone, (Dietz's indicia 13 are directly related to prizes awarded rather than mere symbols. For example, Fig. 1A shows indicia directly related to a prize of \$5.00. The indicia alone are irrelevant because they do not establish a prize amount. Hence, they are interpreted as related to prizes awarded rather than merely symbols in the display zone.)

11. Claims 14, 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Behm (US Pub. No.: 2003/0042317 A1).

Regarding Claims 14, 27: Walker as modified above teaches that the masking medium comprises a first mask (See discussion of Claim 10). Walker as modified above teaches the invention substantially as claimed but does not teach that the game play defining element (i.e. ticket 100 of Fig. 2) includes a further, special feature zone related to a special feature and that prior to game play, it is covered by a second mask.

However, in a related invention, Behm teaches a scratch off lottery ticket 10, which is a game defining element, that includes a special feature zone 40 that is masked by material 22. (See Behm Fig. 1, 2A.) Behm's special feature zone 40 provides a bonus award and is separate from his main game play area 12. Thus, Behm's special feature zone 40 is a further zone, related to a special feature. A player removes the masking and the special feature prize is revealed.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide a special feature zone on Walker's game ticket, such that is covered by a second masking material, as by Behm, for the purpose of enhancing player participation, (Behm, Col. 4. Lines 22-39.)

12. Claims 15, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Behm (US Pub. No.: 2003/0042317 A1) as applied to Claims 14 and 27, in further view of Harrison (US 5,934,671).

Regarding Claims 15, 28: Walker in view of Behm teaches the invention substantially, including that a player removes masking medium of the special feature zone to determine what special prize was won, but does not teach that the player obtains access to the special feature zone only if a special feature indicium is revealed in the symbol interpretation zone.

However, in a related invention, Harrison teaches a symbol interpretation zone in which a special indicium indicates the presence of a bonus. (See Harrison, Fig. 2 and Col. 4. Lines 18-28, disclosing an indication that a symbol combination qualifies the player for a bonus.) It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Walker's symbol interpretation zone (Walker, Fig. 2, zone 140) by providing the potential for a special feature indicium such that once it is revealed, a player obtains access to a special feature such as a bonus, as taught by Harrison, for the purpose of enhancing player participation. Persons of ordinary skill in the art would realize that bonus features tend to attract players and hence, making changes to present such bonus features yields the predictable results of promoting player Interest.

13. Claims 16, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Dietz (US 5,949,042), as applied to Claims 12 and 25, in further view of Kamille (US 6,237,913.)

Regarding Claims 16, 29: Walker in view Dietz teaches the invention substantially as claimed but does not teach, if the spinning reel-type game has fixed pay type operators, headings associated with those operators are not covered by the masking medium with only specific operators applicable to that specific game being covered by the masking medium. However, in a related invention, Kamille teaches a lottery game ticket wherein only some regions of the ticket are coated with a scratch off (or masking) material. (See Kamille, Fig. 1, regions 101-106 are coated with scratch off material.) Other regions showing the game name and instructions are not coated with scratch off material.) Kamille thus evidences that masking some headings on a game ticket yet not masking other headings was known in the art prior to Applicant's invention.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to cover some headings yet leave some headings uncovered in the symbol interpretation zone on the lottery ticket rendered by Walker in view of Dietz, as taught by Kamille, for the purpose of not unnecessarily adding to ticket manufacturing cost by coating areas of the game ticket that do not affect game outcome. This yields costs savings.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action, (i.e. the Section 112 rejection). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lewis can be reached on 571-272-7673. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/577,594
Art Unit: 3714

Page 13

/Omkar Deodhar/
Examiner, Art Unit 3714